

REMARKS

This patent application presently includes Claims 1-52, 58-64 and 66, all of which stand rejected.

Claims 1-4, 11-16, 21-26, 33-35, 37-43, 45-48, 50-52, 58, 60-63, 65 and 66 were rejected under 35 U.S.C. §112, first and second paragraphs. Both rejections were based upon the presence in the claims of "changing image which appears on screen intrusively in a manner which is unpredictable for a user and which is completely beyond user control." These rejections are respectfully traversed. In their present form, the subject matter of the claims is described in such a manner that the process of making and using the claimed invention is well enabled. In addition, the claims are now clear and concise. Although neither the applicant nor the undersigned agrees with this rejection, all of the claims have been amended in order to eliminate this issue.

The only language which has not been modified is the use of the term "intrusively." The examiner should be aware that the term "intrusive" is a term of art that as used with respect to on-line advertising, and those skilled in the art would understand very well what is meant by intrusive advertising, and correspondingly, intrusive introduction of a character. The Murray patent (U.S. Patent No. 6,601,659), which the examiner has cited previously makes this clear. For example, see col. 2, lines 43-46 of the patent. Accordingly, there is no basis to consider "intrusively" as either non-enabling or indefinite.

The term "changing imaging" has been deleted from the claims wherever it appeared.

As for unpredictability, the claims now recite that the character is introduced so that it appears in a position or at a time which is unpredictable for a computer user. The animated character of the invention does not appear on the page being viewed when the page first comes up on the screen, as is the case with Banners, but can appear at any time determined by the software not the user. The character can also appear anywhere on the screen. This is also in contrast to Banner ads which appear in defined positions, for which an empty space appears until the ad fills it (not to the user's surprise). Thus, the user could not possibly predict where or when the character will

desktop and must be caught with the cursor before it can be clicked upon (see paragraph 7, third sentence).

Thus, the Examiner's statement that the Japanese reference discloses a method for modifying an image produced by an application program is simply incorrect. There is not the slightest suggestion in the reference that the icon should appear anywhere but on the desktop, as is conventional. In any event, this is not a proper anticipatory reference if it would require modification. Furthermore, placing the icon anywhere but on the desktop renders the invention unsatisfactory for its intended purpose. For example, if, for some reason an icon were placed in an application program window, it would only be available if that window were open, and the application could not be started at will from the desktop. The fact that this modification suggested by the Examiner renders a reference unsatisfactory for its intended purpose indicates that there is no suggestion or motivation to make the proposed modification, as a matter of law. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

It is also noted that the purpose of the Japanese reference is to generate an icon which moves in a manner that is unknown to the user, so that he must chase the icon with the cursor (see paragraph 7, third sentence of the reference), before he can click on the icon to enable an auxiliary function. In other words, the whole purpose of the invention of the Japanese reference is for the user to *exercise control* over the icon or character. Without the exercise of control over the character, the invention of the Japanese reference becomes inoperative and serves no purpose. Thus, what was said above about a suggested modification making the reference unsatisfactory for its intended purpose applies equally well here.

In accordance with claims 1, 12, 17, 21, 23, 36, 44 and 49, all of which are independent, the animated character is introduced into an image produced by an application program or into content being displayed. This is clearly contrary to the Japanese reference which, as explained above, has a character which is an icon that appears on the desktop.

In addition, in accordance with independent claims 3, 5, 17, 25, 27, 34 and 59, the animated character is introduced into the uppermost layer of an application program window. In the Japanese reference, the character is an icon which appears on the desktop and not in an application program window. Furthermore, these claims provide that a user cannot cover the animated character with other objects. In the Japanese reference, the character would be covered by the full screen window of any application program that is run, or any window can be moved so as to cover the character.

Furthermore, according to independent claims 5, 17, 27, 36, 44, 49 and 59 the animated character overlies an existing image and a portion of the character is transparent so that a portion of the existing image can be seen through it. There is not the slightest teaching or suggestion of this feature in the Japanese reference. Moreover, these claims clearly present a combination of features which the Examiner had indicated as distinguishing over the prior art at a previously held personal interview.

In addition, in accordance with independent claims 1 and 23, the animated character is introduced so that it cannot be controlled by the user while the application program is running. As pointed above, control of the icon character is a fundamental requirement of the Japanese reference. Accordingly, this is a further distinction over that reference.

As can be seen from the preceding discussion, every independent claim includes at least one feature which distinguishes it patentably from the Japanese reference. Accordingly, those claims are not taught or suggested by that reference and are allowable thereover.

The remaining claims are dependent from one of the independent claims and are allowable based upon their dependence from an allowable claim. However, it should be noted that certain of the independent claims (for example claims 63-66) are allowable on their own merits, in that they introduce features which distinguish over the Japanese reference.

For all of the above reasons, all of the claims 1, 22, 34-47 and 58-64 are believed to be allowable over the Japanese reference.

Claims 23-33, 48-52 and 65-66 were rejected as anticipated by Baker U.S. Patent No. 6,002,401. This rejection is respectfully traversed. Baker does not teach or suggest the invention of the present claims.

Baker discloses a pictorial user interface in which a pictorial image is linked to a file directory and identifies that directory. Objects in the pictorial image are icons and are linked to file objects (col. 10, lines 23-28). An animated character is overlaid on the pictorial image and user input causes movement of the animated character relative to the pictorial image (col. 10, lines 28-30). According to Baker, the animated character is made responsive to an input device so that a user can control the movements and actions of the animated character (col. 13, lines 10-13). Baker specifically states that "the animated character roughly corresponds to the cursoral pointer in a WIMP GUI." (Col. 13, lines 17-18). "WIMP GUI" is defined at col. 2, lines 34-40).

Several observations are appropriate. First of all, as was the case with the Japanese reference, the Baker invention is intended to reside on the desktop of the operating system, and nothing else is disclosed. It could not be an anticipatory reference for this reason alone. Furthermore, moving the pictorial user interface to an application program would destroy its effectiveness, since that program would have to run before the pictorial interface could be used. As pointed above, under these circumstances, there is no motivation to make the suggest modification, as a matter of law.

Thus, Baker does not teach or even suggest placing an animated character into the image or content of an application program. As shown above, this is a distinguishing feature of independent claims 1, 12, 17, 21, 23, 36, 44 and 49.

Furthermore, not only does Baker not teach or suggest placement of the animated character in an image produced by an application program, but there is not the slightest suggestion that it be placed in the uppermost layer of that image. As explained above, this is a distinguishing feature of claims 3, 5, 17, 25, 27, 34 and 59.

Of particular interest is the fact that Baker specifically discloses that the animated character is basically a pointer which is under the control of the user in every respect. This is clearly contrary the description in claim 23 that the character is to be out of the user's control while the application program is running, as explained above.

Thus, there is at least one distinguishing feature in each of claims 23, 25, 27, 49, 65 and 66. These are the independent claims among the claims under discussion. The remaining claims depend from one of these claims. Thus, all of the independent claims under discussion are allowable and the dependent claims are allowable owing to their dependence from an allowable claim. As was shown previously, some of the dependent claims are also allowable on their own merits in that they introduce additional features which distinguish patentably.

Applicant's attorney has made every effort to place this patent application in condition for allowance. It is therefore earnestly requested that the present amendment be entered, that the application, as a whole, receive favorable reconsideration and that all of the claims be allowed as presently constituted. Should there remain any unanswered questions the Examiner is requested to call the applicant's undersigned attorney at the telephone number given below.

Dated: September 22, 2004

Respectfully submitted,

By 

Joseph B. Verch

Registration No.: 26,936

DARBY & DARBY P.C.

P.O. Box 5257

New York, New York 10150-5257

(212) 527-7700

(212) 753-6237 (Fax)

Attorneys/Agents For Applicant